

Appl. No. 09/163,778
Atty. Docket No. P-116
Amdt. Dated March 9, 2005
Amdt. to Office Action September 9, 2004
Customer No. 27752

REMARKS

Claims 1 and 3 - 14 are pending in the present application. Claims 1 and 3 - 14 are rejected.

Claims 1, 13, and 14 have been amended. The support for the amendments is found on page 4, lines 3-7 and Example 3 on page 11-12.

It is believed these changes do not involve any introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

The Rejection of Claims 1, 3 - 5, 7 - 9, and 11 - 12 Under 35 U.S.C. § 102(b),
alternatively Under 35 U.S.C. § 103(a) as obvious

The Examiner has rejected Claims 1, 3 - 5, 7 - 9, and 11 - 12 under 35 U.S.C. § 102(b) as anticipated and, alternatively under 35 U.S.C. § 103(a) as having been obvious, in view of disclosure regarding composition of natural beagle milk in Applicant's specification. The Examiner has further rejected Claims 7, 8, 9, 11, and 12; 6 and 14; and 10 and 13 under 35 U.S.C. § 103(a) as having been obvious. The Examiner states that the specification discloses that naturally occurring beagle milk contains various components. Applicants respectfully traverse the Examiner's rejection on the basis of the comments below.

Under § 102, anticipation requires that all the claim elements appear in a single prior art document. "A claim is anticipated only if each and every element set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131 citing *Verdegal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2D 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." MPEP § 2131 citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2D 1913, 1920 (Fed. Cir. 1989). As has been stated in the present specification, commercial canine milk replacers have been previously formulated based upon limited research data. Due to such limited research data, those which are ordinarily skilled in the art have previously been unable to successfully formulate a milk replacer which meets the nutritional needs of the suckling puppy. As such, natural beagle milk, the contents of which having been previously unknown, could not have anticipated the present invention. Additionally, as disclosed in the present specification, the canine milk replacer that is claimed in the present invention

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enhances structural tissue growth which is not seen in natural beagle milk. See Page 12, lines 1-5. Since the art does not disclose each and every element of the present application, it cannot as a matter of law anticipate the present application.

Moreover, Claims 1, 3 - 5, 7 - 9, and 11 - 12 would not have been obvious in view of natural beagle milk. Measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of the invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *In re Dembiczak* 175 F. 3d 994, 999 (Fed. Cir. 1999), citing *W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F. 2d 1540, 1553 (Fed. Cir. 1983). As has been stated in the present specification, commercial canine milk replacers have been previously formulated based upon limited research data. Due to such limited research data, those which are ordinarily skilled in the art have previously been unable to successfully formulate a milk replacer which meets the nutritional needs of the suckling puppy. As such, natural beagle milk, the contents of which having been previously unknown, could not have obviated the present invention. Rather, but for Applicant's independent research leading to the present invention, the contents of such milk may have still been unknown. Respectfully, therefore, it is impermissible hindsight to state that natural beagle milk could obviate an artificially produced canine milk replacer, particularly since the natural beagle milk had not previously been thoroughly characterized.

Additionally, as disclosed in the present specification, the canine milk replacer that is claimed in the present invention enhances structural tissue growth which is not seen in natural beagle milk. See Page 12, lines 1-5. The existence of novel or superior unexpected properties, undisclosed by the prior art, weighs heavily in favor of a conclusion that the claimed composition is not obvious. *Air Products and Chemicals, Inc. v. Chas. S. Turner Co.*, 219 U.S.P.Q. 223, 231 (S.C. 1983).

In view of the foregoing, the present invention is novel and nonobvious and the rejections of Claims 1, 3 - 5, 7 - 9, and 11 - 12 should be withdrawn as being based upon the results of Applicant's own work as set forth in the present specification over the prior art of Reconsideration and withdrawal of the rejection on this basis are requested.

Claims 6 and 14 have been further rejected based on the combination of natural beagle milk and the teachings of Gil. For the same reasons that Claims 1, 3 - 5, 7 - 9,

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and 11 – 12 would not have been obvious in view of natural beagle milk, Claims 6 and 14 would not have been obvious.

Claims 10 and 13 have been further rejected in view of the combination of natural beagle milk and the teachings of Fujimori. Fujimori discloses a pet food for dogs and cats which contains lactosucrose. Fujimori discloses that lactosucrose has distinctive superiority to fructooligosaccharide in metabolizing of intestinal flora. *See* Column 1, lines 58-61. Applicants respectfully submit that it is error to find an invention obvious where prior art references diverges from the invention at hand. *W.L. Gore & Assocs. v. Garlock, Inc.*, 220 USPQ 303, 311 (Fed. Cir. 1983). In determining obviousness, “[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and the obviousness of making the combination.” *Lindeman Maschinenfabrick GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1462 (Fed. Cir. 1984); *Maize*, 5 USPQ 1788, 1793 (Fed. Cir. 1988). One reading Fujimori would not desire to use Applicants’ fructooligosaccharide in a pet dog food since the reference considers this to be inferior to the lactosucrose disclosed in Fujimori. Thus, the reference not only fails to teach or suggest a canine milk substitute comprising fructooligosaccharide as claimed by Applicants, but the reference goes so far as to teach away from such a combination due to the references’ view that this is inferior to the disclosed lactosucrose. Moreover, Fujimori does not even disclose a canine milk substitute, but is rather directed to the use of lactosucrose in pet foods for adult cats and dogs.

Accordingly, Claims 6, 10, 13, and 14 are novel and nonobvious and reconsideration and withdrawal of the rejection is respectfully requested.

The Examiner has rejected Claims 1, 3 – 5, and 9 under 35 U.S.C. § 103(a) as being unpatentable over Meyer (DE 3512705) in view of disclosure regarding composition of natural beagle milk in Applicant’s specification, GB 2030439 and Smirnova et al. The Examiner states that Meyer discloses a milk substitute especially for dogs. However, the Examiner admits that the reference does not disclose the ratio of casein to whey, but the examiner relies on the analysis of milk of various animals was already known in the art at the time the invention was made, therefore the knowledge that casein is more prevalent than whey would have been obvious.

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The Meyers reference fails to disclose or teach a composition comprising, on a dry matter basis, from about 35 to 45% protein, from about 25 to 35% fat, and from about 10 to 25% carbohydrates; wherein said protein comprises casein and whey in a weight ratio of about 70:30; wherein the composition is an artificially produced canine milk substitute; wherein said composition is fed to a canine; and wherein said canine has enhanced structural tissue growth.

GB 2030439 discloses a milk substitute that does not exhibit significant casein coagulation on reconstitution. The composition comprises more than 10% casein. GB 2030439 fails to teach or suggest from about 35 to 45% protein, wherein said protein comprises casein and whey in a weight ratio of about 70:30 and wherein said canine has enhanced structural tissue growth. While GB 2030439 does mention the use of spray-dried whey powder and or non-milk proteins such as soya protein are standard ingredients that can be included it is merely recited as an optional ingredient that can be used and the significance and combination of adding casein and whey at specific ratio is not taught or suggested anywhere in the GB 2030439 or the Meyers reference.

Applicant has obtained an English translation of the Smirnova reference which is believed to be accurate. This translation is submitted herewith accompanied by a Supplemental Information Disclosure Statement. The Smirnova reference discloses a research model being developed for investigation of protein metabolism in the neonatal period resulting in substitutes for breast milk. The Smirnova reference fails to teach or suggest the use of whey in a milk substitute. In fact, the significance and combination of adding casein and whey at specific ratio is not taught or suggested anywhere in GB 2030439, the Meyers reference or the Smirnova reference. There should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the references in such a manner as to arrive at the claimed invention. Where there is no teaching or suggestion, there is no motivation to combine prior art to arrive at the present invention.

Accordingly, Claims 1, 3 - 5, and 9 are novel and nonobvious over Meyer (DE 3512705) in view of disclosure regarding composition of natural beagle milk in Applicant's specification, GB 2030439 and Smirnova et al. and reconsideration and withdrawal of the rejection is respectfully requested.

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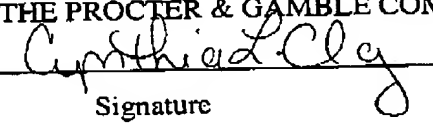
CONCLUSION

In light of the remarks presented herein, Applicants respectfully submit Claims 1 and 3 – 14 are allowable over the cited reference. Reconsideration and allowance are respectfully requested. In the event that issues remain prior to allowance of the noted claims, then the Examiner is invited to call Applicant's undersigned attorney for further discussion.

Respectfully Submitted,

THE PROCTER & GAMBLE COMPANY

By


Signature

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